

**REMARKS/ARGUMENTS**

This Amendment is responsive to the Final Rejection of the Examiner mailed October 3, 2003. The objections of the Examiner to the pending claims are lodged under 35 USC 112, second paragraph. Accordingly, this Amendment seeks to render moot these rejections of the Examiner by appropriate amendment to the claims. The use of the Examiner's discretion in considering this Amendment is respectfully requested.

The Examiner questions claim 1 at the "providing step." Specifically, the Examiner questions whether (1) the volumetric expansion of the selectively activatable layer or (2) the becoming adhesive to a portion of the specimen causes the volumetric expansion. The claim has now been amended so that the "selectively activatable layer which upon activation becomes adhesive to a portion of the specimen and volumetrically expands with the volumetric expansion exceeding a first interval..." Both the expansion and the becoming adhesive to a portion of the specimen occur at the same time.

Claim 5 has been indicated as confusing because the function of the coating was unclear. The penultimate paragraph has been deleted from claim 5. Thus, the selectively activating step of claim 1 causes the coating with the affinity specific bond to contact the specimen and produce the affinity specific bond attachment result. Claim 5 was further objected to at the "exposing" step. This portion of claim 5 has been deleted. It is submitted that the deletion of the penultimate paragraph renders the claim definite.

Claims 9, 10 and 11 have all been objected to as they depend from claim 8. Applicant offers the following explanations.

As set forth in claim 9, in some circumstances the activatable material can expand to and toward the specimen, contact the specimen, and then be allowed to cool and contract. When the activatable material cools and contracts, it will "pull away" the attached portion of the specimen. In this circumstance the activatable layer is not required to move relative to the specimen. See Fig 1D and specification, page 19 lines 17 to 23.

As set forth in claim 10, in some circumstances the activatable material can expand to and toward the specimen, contact the specimen, and then be allowed to again cool and

contract. When the activatable material cools and contracts, it will come under tension, but not pull away from the specimen. In these circumstances, with drawing the activatable layer from the specimen will cause the desired microdissection. See Fig 1C and specification page 19, lines 17 to 23.

As set forth in claim 11, where the targeted portion of the specimen is withdrawn from the remainder of the specimen, what one has is the selectively activatable layer with a series of expanded portions. At the tip of each expanded portion is a selected and targeted portion of the specimen. It turns out that this portion of the specimen can interfere with remaining portions of the specimen, especially when the specimen was not in the first instance entirely planar. Claim 11 sets forth that the contracting volumetric expansion with draws the targeted portion of the specimen free and clear of the remainder of the specimen. See Fig 1G. Note that the protruding portion of the specimen attached to the activated and cooled layer is retracted at a height sufficiently above the remainder of the specimen where interference cannot occur.

Regarding the Examiner's objection to claim 12, applicant has adopted the suggestion of the Examiner for the amendment of the claim.

Regarding claim 14, this claim covers the embodiments set forth in Fig 1F and the specification at page 12, lines 33 to page 13, line 4. This is a "toothpaste tube" type expansion. Specifically, there is a first volume of the activatable material that normally expands. It expands from the volume of the layer down directly to and toward the sample. There is a second end surrounding volume of material. This second end surrounding volume of material expands inwardly to and toward the first volume of material. The expansion of this second volume is not at all unlike the squeezing of a toothpaste tube. The first volume, already fluid because of its activation, is "squeezed" (some more) and is assisted in further expansion to and towards the specimen. See specification page 12, lines 12 to 26. See also Fig1F.

### **CONCLUSION**

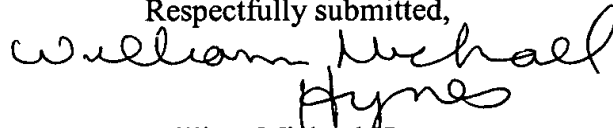
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

Appl. No. 09/456,042  
Amendment under 37 CFR 1.116 Expedited Procedure  
Examining Group

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

A handwritten signature in cursive script that reads "William Michael Hynes". The signature is written in dark ink and is positioned above the printed name.

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